

REMARKS

Reconsideration of the present application in view of the remarks below and the amendments above is respectfully requested.

Following the Advisory Action mailed January 4, 2007, Claims 1, 4-9, 11, 13-17, 25 and 26 were pending in the present application. Claims 1, 4-9, 17, and 24 [sic] were rejected and Claims 11, 13-16, 25 and 26 were objected to. Applicants have amended Claims 1 and 11. Presently, Claims 1, 4-9, 11, 13-17, 25 and 26 are under consideration in this application.

Claim 1 has been amended to delete hydroxy in the definition of R¹. Deletion of elements from a Markush group does not add new matter to the present application.

Claim 11 has been amended to delete unnecessary duplication of the word "compound". This correction of a grammatical/typographical error does not add new matter to the present application.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 4-8 and 17, were rejected under 35 U.S.C. § 102(e) as being anticipated by Agarwal et al., WO 2004/009560.

Applicants respectfully traverse this rejection of Claims 1, 4-8 and 17, under 35 U.S.C. § 102(e) over WO 2004/009560. WO 2004/009560 was filed in the PCT International Bureau July 21, 2003, which is a date later than the September 27, 2002, priority date of the present application. WO 2004/009560 claims priority to an Indian application filed July 22, 2002. WO 2004/009560 is not an effective § 102(e) reference against the invention disclosed in the present application.

WO 2004/009560 is not an effective reference under 35 USC § 102(e) against the presently claimed invention. In view of the remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1, 4-8, and 17 under 35 U.S.C. § 102(e) as being anticipated by Agarwal et al., WO 2004/009560.

Claims 1, 4-8 and 17 were rejected under 35 U.S.C. § 102(e) as anticipated by Agarwal et al., WO 03/084935.

Applicants respectfully traverse this rejection of Claims 1, 4-8 and 17, under 35 U.S.C. § 102(e) over WO 03/084935. WO 03/084935 was filed in the PCT International Bureau, designating the US, April 10, 2003, which is a date later than the September 27, 2002, priority date of the present application. WO 03/084935 has an Indian priority date of April 10, 2002. WO 03/084935 is not an effective § 102(e) reference against the present application.

In view of the remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1, 4-8, and 17, under 35 U.S.C. § 102(e) as being anticipated by Agarwal et al., WO 03/084935.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 4-9, 17 and 24, presently Claims 1, 4-9, 17 and 26, were rejected under 35 U.S.C. § 103(a) as being unpatentable over Agarwal et al., WO 2004/009560.

Applicants respectfully traverse the rejection of Claims 1, 4-9, 17 and 24, presently Claims 1, 4-9, 17 and 26, under 35 U.S.C. § 103(a) over Agarwal et al., WO 2004/009560. As noted above, WO 2004/009560 was filed in the PCT International Bureau July 21, 2003, which is a date later than the September 27, 2002, priority date of the present application, and is not an effective § 102(e) reference against the present application and cannot be applied as a reference for obviousness purposes.

In view of the remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-2, 4-9, 17 and 24, presently Claims 1, 4-9, 17 and 26, under 35 U.S.C. § 103(a) over Agarwal et al., WO 2004/009560.

Claims 1-2, 4-9, 17 and 24 are rejected under 35 USC 103(a) as being unpatentable over Agarwal et al., WO 03/084935 for reasons of record.

Applicants respectfully traverse the rejection of Claims 1-2, 4-9, 17 and 24, presently Claims 1, 4-9, 17 and 26, under 35 U.S.C. § 103(a) over Agarwal et al., WO 03/084935. As noted above, WO 03/084935 was filed in the PCT International Bureau, designating the US, April 10, 2003, which is a date later than the September 27, 2002, priority date of the present application. WO 03/084935 is not an effective § 102(e) reference against the present application, and cannot be applied as a reference for obviousness purposes.

In view of the remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-2, 4-9, 17 and 24, presently Claims 1, 4-9, 17 and 26, under 35 U.S.C. § 103(a) over Agarwal et al., WO 03/084935.

Allowable Subject Matter

The Examiner noted that Claims 11, 13-16 and 25, presently Claims 11, 13-15 and 25, were objected to as being dependent upon a rejected base claim, but noted that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In the previous amendment transmitted September 22, 2006, Applicants had amended Claim 11, from which Claims 13-15 and 25, directly or indirectly depend, and canceled Claim 16. The

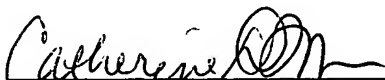
previous amendments to Claim 11 incorporated the limitations of Claims 13 and 25, deemed allowable by the Examiner, by deleting the other indications from the Claim. Still further, Claim 11 was amended to stand in independent form and incorporate the compound of structural formula I, including R1 = hydroxy. The art does not describe the administration of compounds of structural formula 1 in a method of treating a disease mediated by the Cannabinoid 1 receptor selected from substance abuse disorders and eating disorders associated with excessive food intake in a patient in need of such treatment. As amended, Applicants respectfully submit that base Claim 11 is allowable, and hence dependent Claims 13-15 and 25 are also allowable.

In view of this amendment and the remarks above, Applicants respectfully request that the objection to Claims 11, 13-15 and 25 be withdrawn.

Applicants respectfully request reconsideration and withdrawal of the rejection and earnestly solicit a favorable response from the Examiner. The Examiner earnestly is invited to contact Applicants' representative at the number below, if such contact would facilitate prosecution of this application to allowance.

Respectfully submitted,

By



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